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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,182	07/21/2006	Markus Dierker	C 2647 PCT/US	2215

23657 7590 08/28/2009  
FOX ROTHSCHILD LLP  
2000 MARKET STREET  
PHILADELPHIA, PA 19103

EXAMINER
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GULLEDGE, BRIAN M

ART UNIT	PAPER NUMBER
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1619

NOTIFICATION DATE	DELIVERY MODE
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08/28/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/553,182	DIERKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brian Gulledge	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Previous Rejections***

Applicants' arguments, filed June 18, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### ***Claim Objections***

Claim 21 is objected to because of the following informalities: the status identifier of the claim is "new." However, this claim was presented in a previous amendment, and should be listed as "previously presented.". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 12-14 and 16-32 stand rejected and claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Collin (US Patent 6,464,967).** The Applicant argues that the rejection is not proper as the poly- $\alpha$ -olefin mixture instantly recited is made by a different process from different starting materials under different reaction conditions than the material used by Collin. Applicant further argues that the instantly disclosed poly- $\alpha$ -olefin has

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unexpected superior properties with respect to stability. Applicant also argues that [new] claim 33 is not anticipated, as Collin does not suggest the high spreading value that is instantly recited.

The Examiner does not agree with these arguments. As stated in the previous action, the patentability of a product does not depend on the method of production, but rather on the product itself. See MPEP 2113. The Applicant failed to provide evidence that the poly- $\alpha$ -olefin mixture disclosed by Collin cannot be made by the method instantly recited. As for the unexpected properties, secondary considerations cannot overcome a 102 rejection. See MPEP 2131.04. The instant specification discloses that cyclomethicones do not meet the spreading limitation, unlike hydrocarbon-based oils (page 2, lines 2-25). So while Collin is silent as to the spreading value of the poly- $\alpha$ -olefin used, as the material disclosed meets the limitations recited and is also a hydrocarbon oil, it should read on the range recited by instant claim 33.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 15 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Collin et al. (US Patent 6,641,821).** The Applicant argues that the rejection is not proper for the same reasons stated above with regards to Collin. Namely, the poly- $\alpha$ -olefin mixture instantly recited is made by a different process from different starting materials under different reaction conditions than the material used by Collin and the instantly disclosed poly- $\alpha$ -olefin has unexpected superior properties with respect to stability.

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The Examiner does not agree with these arguments. As stated in the previous action, the patentability of a product does not depend on the method of production, but rather on the product itself. See MPEP 2113. The Applicant failed to provide evidence that the poly- $\alpha$ -olefin mixture disclosed by Collin cannot be made by the method instantly recited. As for the unexpected properties, the comparative examples shown in the specification are different from the material disclosed by Collin et al. Furthermore, Collin et al. discloses that the compositions obtained are completely stable and homogeneous over time (column 1, lines 54-58). So the Examiner does not believe the Applicant has provided sufficient data to suggest that the stability of the instantly disclosed poly- $\alpha$ -olefin is unexpected as compared with the material disclosed by Collin et al.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gulledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

/Frederick Krass/  
Supervisory Patent Examiner, Art Unit 1612